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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/493,686 01/28/00 PINSKY

C 9029-6MIS:jb

MM91/0814

EXAMINER

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AIR MAIL

STRECKER, G

ART UNIT

PAPER NUMBER

2862

DATE MAILED:

08/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/493,686	Applicant(s) Pinsky et al
Examiner G. R. STRECKER	Group Art Unit 2862

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

Responsive to communication(s) filed on \_\_\_\_\_

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1 - 31 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) 1 - 31 are subject to restriction or election requirement

### Application Papers

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 21-25, drawn to method of and apparatus for detection of an event in which electron translation is accompanied by photon emission, classified in class 324, subclass 345.
- II. Claims 12-15, drawn to a method of detecting a chemical substance by detecting fluctuations in spontaneous intra atomic electron and nuclear quantum states of a substance, classified in class 436, subclass 2.
- III. Claims 16-20, drawn to a method of detecting a chemical substance by detecting near or propagating electromagnetic fields originating from atoms in the substance, classified in class 436, subclass 149.
- IV. Claims 26-31, drawn to a magnetometer apparatus for detecting a chemical substance based on an electromagnetic field strength produced by spontaneous fluctuations in intra atomic electron and nuclear quantum states of the substance or near or propagating electromagnetic fields originating from atoms in the substance, classified in class 436, subclass 149.

The inventions are distinct, each from the other because:

The invention of Group I is directed to the detection of a different phenomenon than that detected by the inventions of Group II-IV.

Inventions II, III and invention IV are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be

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practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice another and materially different process such as plotting earth's magnetic field, or magnetic scanning in medical applications, or detecting ferrous objects.

The invention of Group III is distinct from the invention of Group II since it is drawn to the detection of different phenomena from that detected by the invention of Group II. In addition, the invention of Group II does not require detection of near or propagating electromagnetic fields as required by the invention of Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication should be directed to G. R. Strecker at telephone number (703) 305-4937.

Strecker/nt

8/9/01

*Gerard R. Strecker*  
GERARD R. STRECKER  
PRIMARY EXAMINER